

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
December 9, 2003

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cristall U.S.A., Inc.
v.
Stockholm Imports, Ltd.

Opposition No. 91123063
to application Serial No. 75686518
filed on April 19, 1999.

David L. Garrison of Garrison and Associates, PS, for
Cristall U.S.A., Inc.

Aaron T. Borrowman of Kelly Bauersfeld Lowry & Kelley, LLP,
for Stockholm Imports, Ltd.

Before Cissel, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 19, 1999, Chester A. Swenson, a United States citizen residing in California, filed the above-referenced application to register the mark "STOCKHOLM KRISTALL" on the Principal Register for "wines, spirits and liqueurs." The basis for filing the application was applicant's assertion that he possessed a bona fide intention to use the mark in commerce in connection with the specified goods. Mr. Swenson subsequently disclaimed the exclusive right to use

the geographically descriptive word "STOCKHOLM" apart from the mark as shown, and amended the application to state that the goods are properly classified in International Class 33. Then the application was amended to claim use of the mark on the stated goods in interstate commerce as early as September of 1999; specimens showing the mark displayed vertically on vodka bottles were submitted; the identification-of-goods clause was restricted to strike reference to "wines"; and the application was assigned to Stockholm Imports, Ltd., a corporation operating under the laws of the state of California.

Following publication of the mark in the Official Gazette, a timely Notice of Opposition was filed by Cristall U.S.A., a corporation of the state of Florida. As grounds for opposition, opposer alleged that it imports Russian vodka for sale in the United States and is the assignee of all rights in the trademark "CRISTALL" from Moscow Distillery Cristall, a Russian entity; that opposer owns United States Trademark Reg. No. 2,336,937 for the mark "CRISTALL" for vodka¹ and Reg. No. 2,301,166 for the same word in stylized lettering, also for vodka²; that Moscow Distillery Cristall has for many years manufactured high

¹ Issued on the Principal Register to opposer on April 4, 2000. The application had been assigned to opposer from Moscow Distillery Cristall.

² Issued to opposer on the Principal Register on Dec. 21, 1999.

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quality Russian vodka, including vodka sold in the United States since 1989 under the marks "STOLICHNAYA CRISTALL," "CRISTALL" and "MOSCOW CRISTALL"; that opposer adopted and is using a label which bears the "CRISTALL" mark oriented vertically on the bottle, as opposed to the conventional horizontal orientation³; and that the mark applicant seeks to register, particularly as used on applicant's vodka with the word "KRISTALL" oriented vertically, so resembles opposer's marks as to be likely to cause confusion, to cause mistake or to deceive.

Applicant answered the Notice of Opposition by denying that confusion is likely, asserting that there had been no actual confusion between the marks and that its mark differs in sound, appearance and commercial impression from the marks pleaded by opposer.

A trial was conducted in accordance with the Trademark Rules of Practice. Both parties took testimony, introduced evidence, filed briefs and argued their respective positions at the oral hearing before the Board.

The record includes the depositions, with exhibits, of Chester Swenson, Chairman of the Board of applicant, and of Frank Pesce, Chairman of the Board and Chief Executive Officer of opposer.

³ Reg. No. 2,548,656, showing the mark presented vertically, was issued on March 19, 2000, based on a claim of use since Feb. 15,

In view of opposer's submission of suitable copies of its pleaded and unchallenged registrations, opposer has established its standing and that priority is not an issue in this proceeding. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). In any event, the record establishes opposer's priority of use. Opposer's predecessor in interest used the mark on vodka imported into the United States as early as 1990, and opposer itself has sold vodka bearing the mark here since 1998. The opposed application, based on the intention to use the mark, was not filed until September of 1999.

We thus turn to determining of the merits of opposer's claim that confusion is likely. Based on careful consideration of the record, the arguments presented by the parties, the statute and the relevant legal precedents, we find that the mark applicant seeks to register is similar to opposer's pleaded mark "CRISTALL" and that the goods on which applicant uses its mark are identical to the products with which opposer has used its mark and for which it has registered its marks. Under these circumstances, confusion is plainly likely.

This conclusion regarding the issue under Section 2(d) of the Lanham Act is based on our analysis of all of the

1997. This registration was introduced into the record in

probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that the basic inquiry mandated by Section 2(d) goes to the cumulative effect of the similarities and differences in the essential characteristics of the goods and the similarities and differences in the marks. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The first issue for our determination is whether the marks, when considered in their entirety, are similar in terms of appearance, pronunciation and meaning, and whether the overall commercial impressions they create, in connection with vodka, are similar. The test is whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under them is likely to result; the question is not whether the marks can be distinguished when they are subjected to a side-by-side comparison. *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999). Our determination must focus on the recollection of the average purchaser of the goods in question, taking into account that such a person normally retains only a general, rather than a

connection with Mr. Pesce's testimony.

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specific, impression of a trademark. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

As noted above, the mark applicant seeks to register is "STOCKHOLM KRISTALL," and opposer's mark is "CRISTALL." Notwithstanding applicant's arguments to the contrary, "STOCKHOLM KRISTALL" and "CRISTALL" are similar in appearance, pronunciation and connotation, and the overall commercial impressions they create in connection with vodka are similar as well. Both marks employ unusual spellings, at least as far as the United States market is concerned, of the word "crystal." Each mark consists of or includes a phonetic equivalent of this word, and each presents the term ending in two "l"s. The record shows that both applicant and opposer intend for their marks to suggest that the vodkas with which the marks are used are crystal clear, so the connotations of "KRISTALL" and "CRISTALL" are the same, as are their pronunciations.

Applicant's argument that the geographically descriptive (and hence disclaimed) term "STOCKHOLM" readily differentiates its mark from that of opposer is not well taken. It is well settled that the addition of descriptive terminology to an otherwise similar mark is normally insufficient to alter the overall commercial impression of the mark to the point where the likelihood of confusion is eliminated. The addition of the geographically descriptive

term to applicant's mark is an insufficient basis upon which to conclude that vodka purchasers are likely to distinguish between these otherwise very similar marks when they are used on identical goods. Applicant's addition of the term "STOCKHOLM" is likely to be understood as an indication of the geographic origin of applicant's vodka. Vodka purchasers familiar with opposer's "Cristall" vodka from Russia are likely to assume that applicant's identical products are produced by the same entity, but from a facility in Stockholm, rather than one in Russia.

For the record, we note that we have not been persuaded by opposer's arguments concerning the vertical orientation of its mark in one of its registrations, or by the argument regarding its predecessor's use of the term "Kristall," spelled with a "K," in its name. The marks are similar even without considering the vertical display, and the fact that Moscow Distillery apparently referred to itself as "Moscow Distillery Kristall" prior to using the name "Moscow Distillery Cristall" is of no avail to opposer. The testimony is less than clear as to when the transition from "Kristall" to "Cristall" took place, much less whether, at the present time, any significant number of purchasers in this country are even aware of the alleged prior use of "Kristall" by opposer's predecessor. In a similar sense, this record does not establish whether or not any such prior

use is likely, at this juncture, to be attributed to opposer. In any event, Moscow Distillery Cristall is not a party to this proceeding and there is no evidence that any rights it may have had in the term "Kristall" have been assigned to opposer. We therefore cannot attribute any use of that term by Moscow Distillery Cristall to opposer.

We further note that we have not been persuaded by applicant's argument that these marks are unlikely to cause confusion because applicant promotes its product by using a Swedish theme, emphasizing the Swedish origin of the goods, whereas opposer promotes the Russian origin of its product. In resolving the issue of whether confusion is likely, we must consider the marks in their entirety, but it would not be appropriate to let the other matter in advertising copy in which the marks are used control with regard to our resolution of the question of whether the marks themselves are likely to cause confusion. As with a display associated with a mark, advertising copy and its emphasis may be changed at any time. Applicant is not attempting to register anything but the word mark "STOCKHOLM KRISTALL."

As both parties concede, the goods are identical. Applicant does put forward the argument that in view of the relatively high prices its vodka commands in the marketplace, the purchasers of its goods are sophisticated purchasers, but we must resolve the issue of whether

confusion is likely based on the goods as they are identified in the application and the pleaded registrations, respectively, without any limitations or restrictions not reflected therein. On that basis, we must conclude that the goods of the parties are identical, moving through the same channels of trade to the same ultimate consumers who are not necessarily sophisticated consumers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

It is well settled that when marks are used on identical goods, in order for confusion to be likely, the marks do not have to be as similar as would be the case if the goods were not the same. *Century 21 Real Estate v. Century Life of America*, 570 F.2d 874, 23 USPQ2d 1098 (Fed. Cir. 1992). As noted above, the issue is not whether the marks can be distinguished based on side-by-side comparison, but rather whether, as used on the same products, the commercial impressions they engender are so similar that prospective purchasers are likely to be confused as to the source of the goods. In the instant case, the similarities discussed above provide more than a sufficient basis for holding that confusion is likely. Even if some doubt remained on this issue, it is well settled that any such doubt would have to be resolved in favor of the prior user and registrant, and against the applicant, who, as the

second comer, had a duty to select a mark that would not be likely to cause confusion with a mark which was already in use by a competitor. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

That no incidents of actual confusion have come to light is not determinative of this dispute. The issue is whether confusion is likely, not whether it has actually taken place. Evidence of actual confusion is not necessary in order for us to find that confusion is likely.

Applicant argues that registration and use of marks which include the phonetic equivalent of opposer's mark for the same or related goods by third parties establishes that opposer's mark is weak; that, as such, it is entitled to only a narrow scope of protection under Section 2(d) of the statute; and that this narrow scope does not encompass marks such as the one applicant here seeks to register. Most of the evidence and testimony applicant cites in support of this argument does not establish the use of these third-party marks. As to the few that have been shown to have been in actual use, we are not provided with sufficient evidence regarding the extent of their use or promotion to conclude that prospective purchasers of vodka in the United States have been exposed to the use of so many marks consisting of or including the term "crystal" or a phonetic

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variation of it in connection with this product that the word has become weak in source-identifying significance.

In summary, priority is not an issue in this case, but if it were, priority would be with opposer; applicant's mark is similar to opposer's mark in commercial impression; and these two similar marks are used on identical goods. Under these circumstances, we hold that confusion is likely.

Decision: The opposition is sustained and registration to applicant is refused.